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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,990	03/16/2004	Donald L. Clason	3270	3925

7590 06/12/2008
THE LUBRIZOL CORPORATION
Patent Administrator - Mail Drop 022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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06/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,990

Applicant(s)

CLASON, DONALD L.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 21-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 18-19, 21-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 6/2/08 fails to overcome the rejections set forth in the office action mailed 1/9/08, which are maintained below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/08 has been entered.

Claim Rejections - 35 USC § 103

3. Claims 18-19, 21-28, and 30-31 rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart.

This rejection is adequately set forth in paragraph 2 of the office action mailed 4/13/07, which is incorporated here by reference.

4. Claims 18-19, 21-31, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Emert.

This rejection is adequately set forth in paragraph 3 of the office action mailed 4/13/07, which is incorporated here by reference.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Byford.

This rejection is adequately set forth in paragraph 4 of the office action mailed 4/13/07, which is incorporated here by reference.

Response to Arguments

6. Applicant's arguments filed 6/2/08 have been fully considered but they are not persuasive. Applicant has amended the claims so that the comparative examples in the declaration dated 10/10/07 are no longer within the scope of the claims, and has submitted a further declaration, signed by Butke and dated 6/2/08, stating that the dispersants used in the compositions of the first declaration are nitrogen-free dispersants described in the specification and within the scope of the claims, and were the same in each composition.

However, the data in the 10/10/07 declaration remains incommensurate with the scope of the claims. While applicant argues that the previous office action "focused" on the issues that have been remedied by the amendment and the further declaration, these were not the only deficiencies identified in the previous office action, which states "The showing is not commensurate with the scope of the claims, as superior results have been reported for only one composition, EX1, which contains specific amounts of primary dialkyldithiophosphate and dispersant, while claim 18 recites any concentration of dispersant and any concentration of any primary metal hydrocarbyl dithiophosphate."

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Applicant has not addressed this concern either through argument or additional evidence, and therefore has not presented sufficient evidence of unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797